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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,588	01/04/2008	Paul T. Breitenbach	03-061	7008
22927	7590	07/09/2009	EXAMINER	
WALKER DIGITAL MANAGEMENT, LLC			HAVAN, THU THAO	
2 HIGH RIDGE PARK				
STAMFORD, CT 06905			ART UNIT	PAPER NUMBER
			3695	
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			07/09/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/581,588	BREITENBACH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	THU-THAO HAVAN	3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 June 2006.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 June 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Drawings***

The drawings were received on June 2, 2006. These drawings are accepted.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on January 18, 2008 and June 2, 2006 is accepted. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With regard to claims 1-25, a claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

*"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.>'); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular*

*apparatus or operated to change materials to a ‘different state or thing’ ’); Cochrane v. Deener, 94 U.S. 780, 788 (1876) (‘A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.’).<sup>7</sup> A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article.” (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))*

Also noted in *Bilski* is the statement, “Process claim that recites fundamental principle, and that otherwise fails ‘machine-or-transformation’ test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere ‘insignificant post-solution activity.’” (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO’s “Guidance for Examining Process Claims in view of *In re Bilski*” memorandum dated January 7, 2009,

[http://www.uspto.gov/web/offices/pac/dapp/ola/documents/bilski\\_guidance\\_memo.pdf](http://www.uspto.gov/web/offices/pac/dapp/ola/documents/bilski_guidance_memo.pdf) .

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495), <http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>.

Claims 1-25 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claims 1-25 are non-statutory under § 101.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. (US 4,654,800) in view of Engstrom (US 5,780,133).

Re claim 1, Hayashi teaches a method comprising: determining, based on profit management considerations, a ...to at least one product available for sale by a vending machine, the ... including at least one term that defines at least one product which may be redeemed pursuant to the ... (col. 1, lines 13-19; figs. 1 and 10);

outputting an offer to purchase the ...; receiving an indication of acceptance of the offer; registering the ...; outputting a code (col. 17, lines 42-67; fig. 12); and

receiving the code and a request to redeem a unit of a product pursuant to the .... (col. 3, lines 18-34; col. 7, line 40 to col. 8, line 42; figs. 2-3);

However, Hayashi does not explicitly teach subscription. On the other hand, Engstrom discloses subscription when he discloses a sheet which is covered to hide coupons and two offers with each coupon (col. 1, lines 40-51; col. 2, line 64 to col. 3, line 21; abstract). Engstrom discloses an improved variable value retail coupon system where at least one coupon with at least two different offers is formed on the sheet and provisions are made to hide the coupon. He hides the offers so that the user does not know the value of the offer he is saving or destroying before he opens the system. Thus, it would have been obvious to one of ordinary skill in the art to enable a vending machine to have a product in relation to a coupon for a particular subscription to attract a customer to buy its merchandise.

Re claim 2, Hayashi teaches at least one term that defines at least one product which may be redeemed pursuant to the subscription defines a category of product, and a number of units of products included in the category which may be redeemed (col. 12, lines 37-68).

Re claim 3, Hayashi teaches receiving a request to redeem a unit of a selected product pursuant to the subscription; and determining whether the selected product is included in the category. (col. 7, line 40 to col. 8, line 42).

Re claim 4, Hayashi teaches defining the category by determining which of a set of all products available for sale are included in the category (col. 16, lines 30-52).

Re claim 5, Hayashi teaches outputting an indication of products which are included in the category (col. 19, lines 18-35).

Re claim **6**, Hayashi teaches receiving from a customer a selection of a subscription of a plurality of subscriptions product (col. 12, lines 37-68).

Re claim **7**, Hayashi teaches receiving an indication of an amount of currency that is tendered to the vending machine; determining whether the amount is greater than a predetermined threshold; and performing the step of outputting an offer to purchase the subscription based on determining whether the amount is greater than a predetermined threshold (col. 14, lines 11-68).

Re claim **8**, Hayashi teaches generating a code (figs. 1 and 13 (product dispenser));

Re claim **9**, Hayashi teaches generating a code comprises: receiving a seven digit number from a customer via a keypad (col. 9, lines 32-59).

Re claim **10**, Hayashi teaches storing the code in association with the subscription, thereby allowing the subscription to be determined from the code (figs. 3a-3d and 10).

Re claims **11-25**, Hayashi and Engstrom teach a method as claimed in claims 1-10. Therefore the rationale applied in the rejection of claims 1-10 applies herein.

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday to Friday from 6am-2pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Thu Thao Havan/  
Primary Examiner, Art Unit 3695